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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,314	01/09/2001	Masayuki Kitagawa	MITUM22.001AUS	6789

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EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,314	KITAGAWA, MASAYUKI	
	Examiner	Art Unit	
	Khanh Dang	2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the essential structural relationships between the so-called "first entity," "second entity," "detector," and "function select mechanism. See MPEP § 2172.01.

With regard to claim 10, the essential structural relationships between the so-called "first entity," "second entity," "detector," and "function select mechanism. See MPEP § 2172.01.

With regard to claim 13, in lines 1-3, the phrase, "selecting one out of ... second functions" is unclear and cannot be ascertained. Also, the following terms lack proper antecedent basis: "first resistance" and "second resistance."

With regard to claim 15, in lines 1-3, the phrase, "selecting one out of ... second functions" is unclear and cannot be ascertained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 10, 11, and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Oguma.

It is first noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure/step that differs from Oguma. With regard to claims 1, 7, 10, and 11, Oguma discloses an apparatus for selecting one out of two functions, comprising: a first entity (6, for example) having a first function, a second function, at least one detector (64, 61) and a function select mechanism (including 62, 63, and 65); a second entity (1, for example) having at least one of the first function and the second function; and an interface (USB Protocol) for connecting the first entity and second entity, the interface (USB) connected to the at least one detector (64, 61); wherein the at least one detector (64, 61) detects a function of the second entity when connected to the first entity, and the function select mechanism selects one out of the first and second functions in the first entity in response to an output of the at least one detector (64, 61) corresponding to the detected function. With regard to claim 2, the first function and the second function are a

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host function and a device function, respectively. See also, Fig. 3 and description thereof). With regard to claim 3, the at least one detector is two detectors (64, 61). With regard to claim 15, one using the device of Oguma would have performed the same method steps set forth in claim 15. With regard to newly added claims 16-18, see explanation above and also discussion under "Response to Arguments."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oguma.

Oguma discloses the claimed invention including the use of at least one detector (61, 64). However, Oguma does not disclose that the detector (61, 64) includes a comparator. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a comparator in the type of detectors (61, 64) disclosed by Oguma, since the Examiner takes Official Notice that such a comparator is notoriously well-known in the art for its use in conventional detecting means (in order to detect, a detector compares the detected value with a reference value), and the selection of a so-called "comparator" for use in Oguma's detectors would be clearly

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within the level of ordinary skill in the art. If Applicant challenges the fact that such a "comparator" is well-known for its use in detectors, supportive documents will be provided upon request.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oguma.

Oguma discloses the claimed invention including the use of a function select mechanism (including 62, 63, and 65). However, Oguma does not disclose that the function select mechanism (including 62, 63, and 65) includes a microprocessor. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a microprocessor for the function select mechanism (including 62, 63, and 65) disclosed by Oguma, since the Examiner takes Official Notice that such a microprocessor is notoriously well-known in the art for its use in selection/computation/automation process, and the selection of a microprocessor for use in Oguma's function select mechanism (including 62, 63, and 65) would be clearly within the level of ordinary skill in the art. If Applicant challenges the fact that such a microprocessor is well-known for its use in selection/computation/automation process, supportive documents will be provided upon request.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oguma.

Oguma discloses the claimed invention including the use a first entity and a second entity (discussed above in the 102 rejection). Oguma does not particularly

disclose that the first entity may be a digital camera and that the second entity may be either a camera (claim 8) or a printer (claim 9). However, Oguma, col. 1, lines 11-25, under "Description of the Related Art," states that it is known in the art to use USB to transfer data/images among various devices such as digital camera and printer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ camera as a first entity and camera or printer as a second entity in Oguma, as taught by the "Related Art", for the purpose of transferring data/image among various devices such as camera and printer.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oguma.

Oguma discloses the claimed invention including the use of a function select mechanism (including 62, 63, and 65). However, Oguma does not disclose that the function select mechanism (including 62, 63, and 65) includes a field programmable gate array or gate array. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a field programmable gate array or gate array in the function select mechanism (including 62, 63, and 65) disclosed by Oguma, since the Examiner takes Official Notice that such a field programmable gate array or gate array is notoriously well-known in the art for its use in selection/computation/automation process, and the selection of a field programmable gate array or gate array for use in Oguma's function select mechanism (including 62, 63, and 65) would be clearly within the level of ordinary skill in the art. If Applicant challenges the fact that such a field programmable gate array or gate array is well-

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known for its use in selection/computation/automation process, supportive documents will be provided upon request.

Response to Arguments

Applicant's arguments filed 10/14/2003 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification can not be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claimed language will not be warranted.

The Oguma 102(e) Rejection:

With regard to claim 1, 10, 11, and 15 (with claims 2-9, and 12 stand or fall together), Applicants argued that "Oguma does not show the detector for detecting a function of the second entity." Contrary to Applicants' argument, at least one detector

(64, 61) of Oguma detects the so-called "function" by detecting the voltage level of a so-called "second entity" (1) when connected to the "first entity" (6). Note that this is identical to the type of detector disclosed by the Applicants in the originally filed specification. Applicants also argued that Oguma "does not show a function select mechanism." Contrary to Applicants' argument, the "function select mechanism" (62, 63, and 65) selects the so-called "first function" (host) or the so-called "second function" (slave) in the "first entity" (6) in response to the output of at least one detector (64, 61).

With regard to newly added claims 16, Applicants argued that in Oguma, the host (1) "cannot be the recited second entity having a device function." Contrary to Applicants' argument, it is clear from Oguma that when the "second entity" (1) is connected to the "first entity" and is in suspended mode (for example), it is no longer a host and therefore, does not exhibit any host functions or bus manager functions. Therefore, it can be simply regarded as a device with device functions.

With regard to newly added claim 17, Applicants argued that Oguma does not disclose or teach the recited second entity which has both a host function and a device function." Contrary to Applicants' argument, it is clear from Oguma that when the "second entity" (1) is connected to the "first entity", it will function as a host with host functions. It is also clear from Oguma that when the "second entity" (1) is connected to the "first entity" and is in suspended mode (for example), it is no longer a host and therefore, does not exhibit any host functions or bus manager functions. Therefore, it can be simply regarded as a device with device functions.

The Oguma 103 rejections:

Applicants did not provide separate arguments regarding the 103 rejections.

Allowable Subject Matter

Claim 13 and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Khanh Dang at
telephone number 703-308-0211.

Khanh Dang

Khanh Dang
Primary Examiner